

REMARKS/ARGUMENTS

Claims 1, 3-5, 9-12 and 15-19 are active. Claim 1 is amended to further define the lipophilic emulsifier in accordance with the disclosure on pages 11-13 and consistent with the comparative data made of record in the present application.

Claims 11 and 12 have been withdrawn but have been retained for the purposes of rejoinder consideration.

Claim 20 is cancelled rendering the rejection under 112, second paragraph inapplicable.

No new matter is added.

The Examiner has maintained the obviousness rejection under 35 USC 103(a) citing U.S. Patent No. 6,645,476. The reasons underlying the rejection remain the same and the Examiner continues to maintain that the evidence that has been provided is not commensurate with the scope of the claims. As apparent from the claims submitted in this paper, the claims have been limited to the specific lipophilic emulsifiers that are used in the data with the types of copolymers.

The '476 patent described preferred water-soluble polymers (col. 3, lines 23-67) including AMPS and fatty alcohol polyglycol ethers (e.g., Genapol® LA-070) that are also used in the context of the present application. The '476 patent suggests the possibility of emulsions (including oil-in-water, col. 9, lines 11-15) and the inclusion of coemulsifiers, such as sorbitan esters and others (see col. 9, lines 27-63). However, none of the Examples provided in the '476 patent include a lipophilic emulsifier and the mere suggestion to include a coemulsifier in col. 9, lines 27-63 fails to illustrate the importance of a lipophilic emulsifier as opposed to another type of emulsifier, particularly considering the rather long and general list of other surfactants, which themselves can act as emulsifiers in certain instances.

Applicants recognize that the presumption of the rejection is that as the emulsifiers are generally known and taught to be used in a composition it would have been obvious to try to combine them with a reasonable expectation of success. Applicants cannot agree with this analysis because that is not the law of obviousness. As explained by the Court of Appeals for the Federal Circuit:

... an invention is not obvious to try where vague prior art does not guide an inventor toward a particular solution. A finding of obviousness would not obtain where "what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." O'Farrell, 853 F.2d at 903. This expresses the same idea as the KSR requirement that the identified solutions be "predictable."

Bayer Schering Pharma AG v. Barr Laboratories, Inc. 2009 U.S. App. LEXIS 17372, 91 U.S.P.Q.2D (BNA) 1569 (Fed. Cir. 2009) (internal citations omitted)

On page 4 of the above-referenced application, it is stated that "the polymers illustrated in the said document do not produce O/W emulsions with cosmetic properties that are very pleasant for the user while at the same time being very stable and easy to produce." Comparative Examples 1 and 3 in the above-referenced application shows that emulsions containing the polymer as the only emulsifier were not stable.

The '476 patent describes oil-in-water emulsions in Examples 41-43 while the other examples are water-in-oil or water-based compositions. Example 41 includes a hydrophilic co-emulsifier (sodium cocyl glutamate) and Examples 42 and 43 contain no co-emulsifiers.

Seeking to solve this problem, the present inventors have found that by carefully selecting the emulsifier and particularly a lipophilic emulsifier from all those that are known generally in the field, including that taught by the '476 patent, emulsions that are pleasant to the user and remain stable over time and varying temperatures could unexpectedly be

obtained (see page 4 of the present application). That the '476 patent teaches very different compositions, with only general disclosure as to what could be included in such very different compositions, there is simply nothing in '476 patent that suggests to the problem underlying the present invention. The disclosures that are relied upon in the rejection are only "general guidance" (*Id.*) and simply are not the "finite disclosure" and guidance to "a particular solution" that the law requires. (*Id.*). The '476 patent simply has not suggested to specifically include at least one lipophilic emulsifier selected from the group consisting of glyceryl stearate, PEG-8 isostearate, and sorbitan isostearate (see Claim 1).

Further as has already been discussed and at least, in part, considered by the Office, the present application provides comparative data demonstrating the importance of including a lipophilic emulsifier (see comparative Examples 1 and 3) but not other types of emulsifiers (see comparative Example 2). Even in view of what is described in the '476 patent, that a lipophilic emulsifier (further examples follow) resulted in such a dramatic difference compared to other emulsifiers could not have been reasonably predictable.

The tests submitted in the Declaration provide two additional examples of a silicone surfactant and a sucrose ester, which are two additional examples of a lipophilic emulsifier as provided in the above-referenced application.

The compositions obtained are in the form of fine and stable emulsions (fluid milk), the viscosity of each composition being measured using a Rheomat 180 machine at 25°C at a shear rate of 200 s<sup>-1</sup> using a No. 2 spindle.

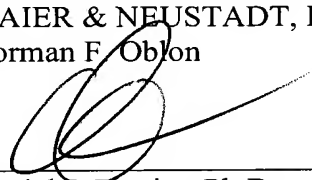
One of the criticisms lodged against the claims and the data presented is that the claims were not deemed to be commensurate in scope with the data presented. It should be readily apparent that based on the Examples in the specification, see Examples 1-4, and the two additional Examples presented in the Declaration are representative of the limited

number of lipophilic emulsifiers that are now defined in Claim 1: "glyceryl stearate, PEG-8 isostearate, sorbitan isostearate."

Withdrawal of the rejections and a Notice of Allowance is requested.

Respectfully submitted,

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